



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,264	03/07/2000	Michael C. Weaver	004528.P001	1291

7590 03/07/2002

Blakely Sokoloff Taylor & Zafman LLP
7th floor
12400 Wilshire Boulevard
Los Angeles, CA 90025

EXAMINER

CHEN, TE Y

ART UNIT	PAPER NUMBER
----------	--------------

2171

DATE MAILED: 03/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/520,264

Applicant(s)
Weaver et al.

Examiner
Te Chen

Art Unit
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Mar 7, 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

Art Unit: 2171

DETAILED ACTION

1. Claims 1 - 34 are presented for examination.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 17-22 and 33, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. As to claim 17, line 7 and claim 20, line 8, the use of the phrase "being capable of" or "capable of being" is inappropriate, since these phrases leads to uncertainty of whether anything actually occurs or results.

5. As to claims 18-19, 21-22 and 33, these dependent claims have the same defects as their base claims, hence were rejected for the same reasons.

Claim Rejections - 35 USC § 102

Art Unit: 2171

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 1-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Beck et al. (U.S. Patent. No. 6,332,154).

8. As to claim 17, Beck et al. (Thereinafter referred as Beck) disclosed a network node, comprising: a server couple to a database system, wherein the database system having indexed electronic documents and electronic characteristics of the documents format, such that the server will use the stored information to search for electronic documents matching user's query and provide search results to the user [57, 75, 77, 79, Fig. 1; col. 10, lines 16-20; col. 11, lines 13-25; Fig. 12 , Fig. 13].

9. As to claim 18, in addition to all features of claim 17, Back further disclosed that the server stores user-input information associated with representations of electronic documents [col. 10, lines 34-40; 287, Fig. 14; col. 34, lines 50-54].

Art Unit: 2171

10. As to claim 19, in addition to all features of claim 17, Back further disclosed that the electronic documents comprise E-mail messages having threading information [Fig. 8; col. 6, lines 53-56].

11. As to claim 20, Back disclosed the claimed system substantially comprising:
a conversion engine to convert electronic legal documents into a database format [col. 10, line 62 - col. 11, line 7; col. 22, lines 10-14]; and
a server coupled to the conversion engine and communicatively coupled to a database system, wherein the server capable of using the indexing information and the electronic characteristics to provide search results to the user node in responsive to the search query [77, 79 Fig. 1; col. 10, lines 23-33; col. 11, lines 29-30; 51-53].

12. As to claim 21, in addition to all features of claim 20, Back further disclosed that the system will load the electronic legal documents into database system by the following steps:
extracting a plurality of electronic documents provided from a source [109, 113, Fig. 3];
identifying a plurality of objects having different data formats for each of the extracted electronic documents via the electronic characteristics [97, Fig. 3];
storing data associated with the identified objects in a first location in the database system [col. 10, lines 51-59];

Art Unit: 2171

converting the other identified objects and storing data associated with the converted objects in a second location in the database system [col. 10, lines 23-31]; and
indexing the data stored in the first and second locations [col. 11, lines 51-53] .

13. As to claim 22, in addition to all features of claim 20, Back further disclosed that a first server unit to store indexing information associated with text context of the electronic documents [79, Fig. 1; 75, Fig.1]; and a second server unit to store indexing information associated with metadata content of the electronic documents [57, Fig. 1; 275, Fig. 12].

14. As to claims 23-30 and 33, these claims recited the same limitations as claims 17-22 in form of machine-readable medium product or network node, hence were rejected for the same reasons.

15. As to claims 1-16, 31-32 and 34, the steps in the claimed method are deemed to be made inherit by the functions of the apparatus structure of claims 17-22, in the combination discussed above, hence were rejected for the same reasons.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hall et al. (U.S. Patent No. 6,138,119) which disclosed using metadata to create an

Art Unit: 2171

abstract representation of a rule based management data structure; Sitka (U.S. Patent No. 6,330,572) which disclosed A system and method for managing the storage of files within an HSM system incorporate an architecture and methodology that facilitate the storage and retrieval of large image files as part of an overall image processing workflow.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan Chen whose telephone number is (703) 308-1155. The examiner can normally be reached Monday through Friday from 7:30 A.M. to 4:30 P.M.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436. The fax phone numbers for this group are: (703) 746-7238 (After Final Communication); (703) 746-7239 (Official Communications); and (703) 746-7240 (For Status Inquiries, Draft Communication).

19. Any inquiry of a general nature of relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-9600.

Susan Chen

SC
Feb. 26, 2002


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100